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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,545	12/14/2001	Carlton Mann		8126

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EXAMINER

PARKER, FREDERICK JOHN

ART UNIT	PAPER NUMBER
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1762

7

DATE MAILED: 06/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/017,545

Applicant(s)

Examiner

Group Art Unit

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE - 3 - MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- ☒ Responsive to communication(s) filed on 5/6/03
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-36 is/are pending in the application.
- Of the above claim(s) 16-36 is/are withdrawn from consideration.
- ☒ Claim(s) 8-15 is/are allowed.
- ☒ Claim(s) 1-7 is/are rejected.
- ☐ Claim(s) is/are objected to.
- ☐ Claim(s) are subject to restriction or election requirement

## Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some\* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

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## DETAILED ACTION

### *Election/Restriction*

1. Applicant's election with traverse of group I, **claims 1-15** in Paper No. 5 is acknowledged. The traversal is on the ground(s) that (1) the cited alternative is not equivalent to the instant process because applying sacrificial tape requires more labor, and (2) the suggestion of frames as an alternative to hooks is contemplated in the instant specification. This is not found persuasive because (1) there is nothing that requires the reasons for restriction provided by the Examiner be less labor intensive or more practical/ economical. The restriction properly provided a different apparatus for carrying out the method as required by statute; and (2) the mere fact the Applicants bring to the Examiner's attention that one of his alternative holding means, frames, was contemplated supports the additional alternative clamping means. Further, Applicants provide no reasons as to why C-clamps or other clamping means other than hooks cannot be used in the method. The requirement is still deemed proper and is therefore made FINAL.

Cancellation of non-elected claims before allowance is requested.

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***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-7 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for coating substrate hooks for use in a painting process, does not reasonably provide enablement for applying the combustible coatings to any surface for subsequent removal of paint build-up, e.g conveyor chain, track, trolley, etc. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to carry out the invention commensurate in scope with these claims. See col. 2, 13-19; figure 2 and accompanying text; col. 4, 9-13; etc.

4. Claims 1-7 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the coating method prior to electrostatic application of a paint, does not reasonably provide enablement for a pretreatment prior to non-electrostatic painting. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to carry out the invention commensurate in scope with these

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claims. The specification is limited to a priming pretreatment prior to electrostatic painting.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 1 is vague and indefinite because it is unclear why one would want to apply a conductive primer coat in preparation for applying paint by non-electrostatic means, e.g. brushing, sprinkling, etc.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mirabeau et al US 5114756.

Mirabeau et al teaches to apply a conductive primer layer comprising conductive particles in a polymeric resin base, e.g epoxy (inherently combustible) which is applied to a conductive metal substrate by spraying, electrostatic spraying (encompassing powder coating), etc prior to drying ("hardening"). The conductive particles are electro-conductive antimony-tin oxide. See col. 2,33-36 & col. 6, 41-57. However, it is stated in the "Background" section that conductive carbon particles added to primer coats applied to a metal surface prior to electrostatic painting is known so that it

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would have been obvious to use such particles when the dark color they produce in the primer coat is not an issue. While not expressly stated, it would have been apparent that the conducting particles are "finely divided" to assure uniform conductivity during electrostatic painting.

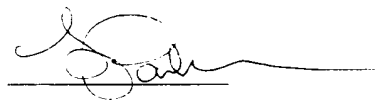
It would have been obvious to one of ordinary skill in the art at the time the invention was made to carry out the method of Mirabeau et al by incorporating finely divided carbon as the conductive particles in the hardened primer layer to be electrostatically painted because carbon particles are known to provide the necessary degree of conductivity for effective electrostatic spraying.

10. Claims 5-7 distinguish over the prior art which does not teach to remove the paint and primer layer together by thermal, chemical, or mechanical means prior to another such application. Claims 5-7 are objected to for depending from a rejected base claim. Claims 8-15 distinguish over the prior art which does not teach nor suggest using the recited conductive primer on product support hooks in an electrostatic painting process. The resultant paint coated hooks are then subjected to thermal, chemical, or mechanical removal treatment prior to another such application.

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11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The additional references illustrate the state of the art in which article support hooks which are either non-conducting or are simply hangers subjected to a thermal or chemical cleaning.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fred J. Parker whose telephone number is (703) 308-3474.



Fred J. Parker

June 16, 2003

10-017545

**FRED J. PARKER  
PRIMARY EXAMINER**